UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,098	05/03/2002	Shogo Ishioka	011713	5721

38834 7590 04/07/2006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER	
ROSEN, NICHOLAS D	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,098	ISHIOKA ET AL.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 May 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11 have been examined.

In view of the Appeal Brief filed on January 20, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below (at the bottom of the Office action).

Claim Objections

Claims 4-6 are objected to because of the following informalities: In the sixth line of claim 4, "said user" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent 6,108,639) in view of official notice. Walker discloses an information service method for providing information via a network including a first information-processing apparatus and a second information-processing apparatus, said information service method comprising steps of: inputting identification of a product for purchase from a user of said network to said first information-processing apparatus (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); transmitting identification information of said product to said second information-processing apparatus (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-

54); and storing said user identification information and product identification information in said second information-processing apparatus (column 8, line 66, through column 9, line 22; Figure 7); transmitting identification information of the user (buyer) is obvious from information being on file (column 8, line 66, through column 9, line 6). Walker does not expressly disclose inputting an order for a surrogate investigation of said product from the user to said first information-processing apparatus, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information-processing apparatus, but does disclose the second information-processing apparatus using product identification information to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent (Abstract; column 7, line 24, through column 8, line 4); and providing information obtained from said identification to said user, presumably identified on the basis of the user identification (Abstract; column 5, lines 21-39; column 12, lines 35-58). Official notice is taken that it is well known for buyers to submit orders for services they wish to receive, related to products they seek to purchase. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user to input an order for a surrogate investigation of the product, and transmit an instruction on said surrogate investigation to the second information-processing apparatus, for the obvious advantages of determining whether the user wanted surrogate investigation, perhaps determining what type or level of surrogate investigation the user wanted, and obtaining the user's authorization to pay

for such an investigation, as it is stated that authenticators/surrogate investigators derive profit (column 3, lines 4-6), implying that they receive fees.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 1 above, and further in view of Vanechanos, Jr. (U.S. Patent 5,884,309). Walker does not disclose a step of publishing information for designating a store and information about products dealt by said store on the network including first and second information-processing apparatus, wherein said user identifies a product for purchase among said published products, but this is a description of standard electronic commerce, especially electronic commerce in a virtual mall, as taught, for example, by Vanechanos (column 2, lines 46-63; column 6, line 63, through column 7, line 26; column 15, lines 43-47; column 19, line 53, through column 20, line 21). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include this step, for the obvious advantage of enabling users to locate and purchase desired products.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 1 above, or Walker, Vanechanos, and official notice as applied to claim 2 above. Walker does not expressly disclose that the step of inputting an order for a surrogate investigation includes designating the level of said investigation or a deadline for the answer of said investigation, but does disclose different levels of investigation (validation, authentication, and, if desired, guarantee; column 3, lines 39-50; column 13, line 60, through column 14, line 4). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention for the step of inputting an order to include designating the level of said investigation or a deadline for the answer of said investigation, for at least the obvious advantage of determining whether a further level of investigation was desired, and whether a user was willing to pay for a further level of investigation/guarantee.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent 6,108,639) in view of official notice. Walker discloses an information service system for providing information via a network, said information service system comprising: a first information-processing apparatus and a second information-processing apparatus, said first information-processing apparatus including: means for acquiring identification information of a product for purchase (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); means for transmitting identification information of said product to said second information-processing apparatus (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); and said second information-processing apparatus including: means for storing user identification information and product identification information with a certain association therebetween (column 8, line 66, through column 9, line 22; Figure 7); means for transmitting identification information of the user (buyer) is obvious from information being on file (column 8, line 66, through column 9, line 6). Walker does not expressly disclose acquiring an order of a surrogate investigation of said product from the user, and transmitting an instruction on said surrogate investigation from said first information-processing apparatus to said second information-processing apparatus, but

does disclose the second information-processing apparatus using product identification information to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent (Abstract; column 7, line 24, through column 8, line 4); and providing information about a result of a physical investigation by an appointed investigation agent to the user, said investigation being related to said identified product (Abstract; column 5, lines 21-39; column 12, lines 35-58). Official notice is taken that it is well known for buyers to submit orders for services they wish to receive, related to products they seek to purchase. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the first information-processing apparatus to acquire an order for a surrogate investigation of the product, and transmit an instruction of said surrogate investigation to the second information-processing apparatus, for the obvious advantages of determining whether the user wanted a surrogate investigation, perhaps determining what type or level of surrogate investigation the user wanted, and obtaining the user's authorization to pay for such an investigation, as it is stated that authenticators/surrogate investigators derive profit (column 3, lines 4-6), implying that they receive fees.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 4 above, and further in view of Vanechanos, Jr. (U.S. Patent 5,884,309). Walker does not disclose that the acquiring means is operable to acquire the identification information of a product for purchase and the order in parallel with publishing information for designating a store and information about

products dealt by said store on the network to provide said products to the user, but this is a description of standard electronic commerce, especially electronic commerce in a virtual mall, as taught, for example, by Vanechanos (column 2, lines 46-63; column 6, line 63, through column 7, line 26; column 15, lines 43-47; column 19, line 53, through column 20, line 21). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the acquiring means to be operable as described, for the obvious advantage of enabling users to locate and purchase desired products.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 4 above, or Walker, Vanechanos, and official notice as applied to claim 5 above. Walker does not expressly disclose that the acquiring means is operable to acquire designated information about the level of said investigation or a deadline for the answer of said investigation from said user, but does disclose different levels of investigation (validation, authentication, and, if desired, guarantee; column 3, lines 39-50; column 13, line 60, through column 14, line 4). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the acquiring means to be operative to acquire this designated information from the user, for at least the obvious advantage of determining whether a further level of investigation was desired, and whether a user was willing to pay for a further level of investigation/guarantee.

It is noted that claims 4-6 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35

U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent 6,108,639) in view of official notice. Walker discloses a server apparatus to be connected to an information-processing terminal via a network, said information-processing terminal including means for acquiring identification information of a product for purchase (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); and means for transmitting identification information of said product to said server apparatus (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); and said server apparatus comprising: means for storing user identification information and product identification information with a certain association therebetween (column 8, line 66, through column 9, line 22; Figure 7); means for transmitting identification information of the user (buyer) is obvious from information being on file (column 8, line 66, through column 9, line 6). Walker does not expressly disclose the information-processing terminal acquiring an order for a surrogate investigation of said product from the user, and transmitting an instruction of said surrogate investigation to the server apparatus, but does disclose the server system using product identification information to identify said product so as to conduct a

physical investigation of said identified product by an appointed investigation agent (Abstract; column 7, line 24, through column 8, line 11); and providing information about a result of a physical investigation by an appointed investigation agent to the user, said investigation being related to said identified product (Abstract; column 5, lines 21-39; column 12, lines 35-58). Official notice is taken that it is well known for buyers to submit orders for services they wish to receive, related to products they seek to purchase. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the information-processing terminal to acquire an order for a surrogate investigation of the product, and transmit an instruction of said surrogate investigation to the server apparatus, for the obvious advantages of determining whether the user wanted a surrogate investigation, perhaps determining what type or level of surrogate investigation the user wanted, and obtaining the user's authorization to pay for such an investigation, as it is stated that authenticators/surrogate investigators derive profit (column 3, lines 4-6), implying that they receive fees.

Walker does not use the word server, but the central controller 200 (Figure 1; column 6; and elsewhere) is held to constitute a server based on its described functionality.

(It is further noted that, as claim 7 is directed to claiming a server apparatus, it is doubtful whether features of the terminal to which the server apparatus is to be connected could be a basis for patentability in any event.)

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 7 above, and further in view of the Microsoft Press Computer Dictionary. Walker does not disclose that a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus, but computer readable media storing programs used to cause computers to carry out their desired functions are well known, as taught, for example, by the Microsoft Press Computer Dictionary (definitions of program and program file on page 384, and definitions of disc and disk on page 150). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the server apparatus to have a computer-readable medium storing a program, for obvious advantage of causing a computer to carry out its desired functions, which would not occur without programming.

It is noted that claim 7 and 8 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent 6,108,639) in view of official notice. Claim 9 is obvious on the same grounds set forth with regard to claim 7 above.

(It is further noted that, as claim 9 is directed to claiming an information-processing terminal, it is doubtful whether features of the server apparatus to which the information-processing terminal is to be connected could be a basis for patentability in any event.)

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 9 above, and further in view of the Microsoft Press Computer Dictionary. A computer readable medium storing a program is obvious on the same grounds set forth with regard to claim 8, for the obvious advantage of causing a computer to carry out its desired functions as an information-processing terminal, which would not occur without programming.

It is noted that claims 9 and 10 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent 6,108,639) in view of official notice. Walker discloses an information service method comprising the steps of: acquiring identification information of a product for purchase designated by an applicant via a network (column 4, lines 9-20; column 5, lines 58-67; column 6, lines 15-27 and 41-54); storing said applicant identification information and product identification information (column 8, line 66, through column 9, line 22; Figure 7); and providing information obtained from a physical investigation of the product by an appointed investigation agent to the applicant, presumably identified on the basis of the stored identification (Abstract; column 5, lines 21-39; column 12, lines 35-58); and it would have been obvious to provide the information via the network, given Walker's disclosure of network communication (e.g., column 6, lines 41-54). Walker does not expressly disclose acquiring identification of an applicant, but does disclose storing applicant identification information and product identification information (column 8, line 66, through column 9, line 22; Figure 7), from which acquiring the applicant identification is obvious, as information must be acquired to be stored. Walker does not disclose acquiring an order for a surrogate investigation of the product from the applicant via the network, but discloses communication over a network, as noted, and official notice is taken that it is well known for buyers to submit orders for services they wish to receive, related to products they seek to purchase. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of patent applicant's invention to acquire an order for a surrogate investigation of the product from the buyer/applicant via the network, for the obvious advantages of

determining whether the applicant wanted surrogate investigation, perhaps determining what type or level of surrogate investigation the user wanted, and obtaining the user's authorization to pay for such an investigation, as it is stated that authenticators/surrogate investigators derive profit (column 3, lines 4-6), implying that they receive fees.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bezos et al. (U.S. Patent 6,029,141) disclose an Internet-based customer referral system, including an electronic shopping cart that allows the customer to select products from multiple different Web sites. Toohey (U.S. Patent 6,405,176) discloses a method for processing multiple electronic shopping carts (for shopping at multiple e-commerce shops in an e-commerce mall). Kuriki et al. (U.S. Patent 6,898,621) disclose a message processing device and management method, including selection of an investigation with a time limit as a message type (see last paragraph in column 4).

Koll ("Shopping on Vacation When You're Traveling, Check out the Local Stores") discloses receivers performing the service of inspecting purchases, checking for damage, etc. (see especially five paragraphs beginning from "It's better to receive").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's current acting supervisor, Mark Fadok, can be reached at 571-272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
March 31, 2006

MARK FADOK
Mark Fadok
AUTH SPE
AU 3625